

### **Remarks**

This is responsive to the Board's Decision mailed August 31, 2009. Applicant hereby opts to amend the rejected claims and thereby reopen prosecution in accordance with 37 CFR 41.50(b). The amendments contain no new matter and are entirely tangentially related to patentability, not made for reason of patentability in response to a rejection over a cited reference.

### **Rejection Under Section 112(2)**

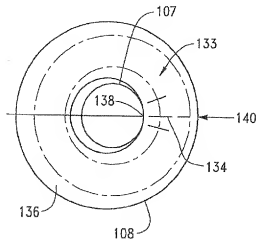
The Board rejected claims 1, 3, 5-9, and 21 as allegedly being indefinite. The Board's rationale is that the rejected claims are allegedly indefinite because the phrase *common angular reference axis* is allegedly neither used nor disclosed in the specification. The Board asserts that the skilled artisan having read the specification would not understand what the disputed term refers to. The Board suggests the skilled artisan would be confused as to whether the *common angular reference axis* is a cylindrical axis, a polar axis, or a rectangular axis.

Importantly, the meaning of the disputed term *common angular reference axis* must be considered in the context of the entirety of the claim language, of which it forms a part. Considering the context, claim 1 plainly states that the servo tracks are offset in relation to the disputed term: *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc....*

The mere fact that a term used in the claim lacks explicit usage in the specification disclosure does not necessarily mean that the term is indefinite. There is no requirement that the words in the claim must match those used in the specification. Applicant is supposed to

be given a great deal of latitude in how it chooses to define its invention so long as the terms and phrases that are used define the invention with a reasonable degree of clarity and precision.<sup>1</sup>

Applicant has shown that FIG. 2 clearly depicts the prewritten disc 108 as having servo tracks (depicted by broken circles) characterized by a concentricity offset with respect to the disc center, in the direction of an angular (or “radial”) axis that is collinear with the alignment mark 134;<sup>2</sup>



The method of FIG. 3 and the descriptions thereof disclose in block 202 using a set of discs,  $N_{TOTAL}$ , having the same (or “common”) pattern of concentricity offset in the direction of the radial axis that is collinear with the alignment mark 134. It is clear that  $N_{TOTAL}$  is a number of discs greater than just one disc, because when it is determined in block 212 that  $N=N_{TOTAL}$  then in block 214 the plural discs are clamped. That is consistent with Applicant’s usage of the term “common” to ordinarily mean that the “angular reference axis” is the same for all of the discs in the set  $N_{TOTAL}$ .

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<sup>1</sup> MPEP 2173.05(e).

Thus, the skilled artisan having read the specification clearly understands that the featured *offset in relation to a common angular reference axis* finds explicit support in the specification in terms of the offset of the servo tracks in a direction within the plane in which the disc 108 resides. For that reason, contrary to the Board's rationale, the skilled artisan clearly would not confuse the featured *common angular reference axis* as being in the direction of a cylindrical axis, which is orthogonal to the plane of the disc 108. Neither the disclosed concentricity offset, nor any other offset, is disclosed or suggested as being in a direction within a plane other the plane in which the disc 108 resides.

The skilled artisan further understands that both of the other two axes suggested by the Board, a polar axis and a rectangular axis, can be used to map locations within the same plane in which the disc 108 resides. As such, again contrary to the Board's rationale, the skilled artisan would not confuse the featured *common angular reference axis* as being either a polar axis or a rectangular axis because either of them can be used to define the angular disposition of the alignment mark 134; the broadest reasonable interpretation of *common angular reference axis* that is consistent with the term's ordinary meaning and usage in the specification encompasses both polar and rectangular coordinate axes.

For these reasons Applicant believes the Board's ultimate conclusion is in error because it hinges on its misplaced premise that "The Specification does not describe the Appellant's invention in terms of a "common angular reference axis," and a person of ordinary skill in the art would not understand what axis is being referred to.<sup>3</sup>

That misplaced premise causes the Board to unexplainably limit what the specification does explicitly disclose. That is, Applicant agrees with the Board to the extent

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<sup>3</sup> See Oral Argument pg. 3; Reply Brief pg. 3.

that the specification discloses the servo track pattern being characteristically disposed with respect to the alignment mark 134.<sup>4</sup> However, the Decision is silent regarding the disclosure and evidence in the record that in alternative disclosed embodiments the discs 108 do not have the alignment marks 134.<sup>5</sup> The skilled artisan understands that in those embodiments the concentricity offset of the servo tracks depicted in FIG. 2 is the same, but there is no alignment mark 134. Rather, the concentricity offset in those embodiments is in relation to an angular axis in the plane of the disc 108, such as could be defined by a polar or a rectangular coordinate axis, in the direction of the alignment depicted in FIG. 2 by the alignment mark 134.

Nonetheless, Applicant has amended claim 1 solely in order to dispose of this issue and move forward on the merits by replacing the disputed term “angular reference axis” with the equivalent replacement term “alignment axis.” Applicant believes using “alignment” in the replacement term obviates the Office’s indefiniteness concern because “alignment” is explicitly used in the specification. Applicant has not included “mark” in the replacement term because, as discussed, Applicant desires and believes it is entitled to a claim scope that encompasses more than just some of the disclosed embodiments. Applicant’s use of “axis” in the replacement term is not indefinite because, as discussed, the meaning of “alignment axis” cannot be reasonably ascertained outside the context of the claim language of which it forms a part. Claim 1 is further amended without prejudice to more particularly fashion the context to feature the *concentricity offset* being disposed in a *direction of an alignment axis...in relation to a center of the respective prewritten disc....* This plainly features the

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<sup>3</sup> BPAI Decision, ppg. 4-5.

<sup>4</sup> BPAI Decision pg. 4.

<sup>5</sup> See para. [0031] of published application; transcript of Oral Hearing ppg. 10-11.

concentricity of the servo tracks as being offset in a direction of the alignment axis in relation to the disc center. Further, although not required for definiteness, all the language of amended claim 1 enjoys explicit support in the specification.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom in view of the clarifying amendments to the claims.

### **Conclusion**

This is a complete response to the Board's Decision. Applicant respectfully requests passage of all claims to allowance.

Applicant has also submitted herewith a request for telephone interview if, after having reviewed this Response, the Office determines that any of the claims are not in condition for allowance. The presently requested interview is necessary and appropriate to best facilitate progress on the merits and to resolve any unsettled issue addressed by Applicant in this Response.

The Office is encouraged to contact the undersigned should any question arise concerning this response or anything else concerning this case.

Respectfully submitted,

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